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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/472,100 | 12/20/1999 | HENRY WHITFIELD | ADEX0001 | 8312 |
| 22862 | 7590 | 04/11/2006 | EXAMINER | |
| GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025 | | | ABDI, KAMBIZ | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |
| DATE MAILED: 04/11/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/472,100 | WHITFIELD, HENRY | |
| | Examiner | Art Unit | |
| | Kambiz Abdi | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- No claim has been amended.
- No claim has been added.
- No claim has been canceled.
- Claims 1-30 have been considered.

2. The petition filed on 5 December 2005 for revival of the application has been granted and a copy of the Grant of revival has been mailed on 1 February 2006.

Response to Amendment

3. Applicant's arguments filed 5 December 2005 have been fully considered but they are not persuasive.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. The Federal Circuit recently has been distinguishing the rulings of *In re Lee* and *In re Dembiczak*. I mentioned to you earlier the recent holding in *In re Johnston*. The recently ruling of *In re Kahn* supports this trend as well. Note the following:

"A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d

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1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

6. Therefore, the argument set forth by the applicant in regards to the combination of the prior art and how their combination would obviate the claimed invention is not persuasive. The teachings of Tedesco and Walker clearly are directed towards the issuing of a pre-funded issuance of value bearing documents or vouchers, which has been clearly and explicitly disclosed by the references. Also examiner has clearly pointed out that the specifics of the teachings as what has been lacking in Tedesco is thought by the Walker reference. Although Tedesco mentions that goods are attained by using the pre-funded check [0067], but Tedesco is not specific on the relationship of the goods and the entity granting the pre-funded certificate (check). However Walker clearly discloses the pre-funded certificate is used to pay for goods and/or services which are related to the specific provider (See Walker column 5, lines 25-38 and column 9, lines 24-29). It is clearly common an obvious knowledge to the one skilled in the art that a gift certificate is bought to be given to some one other than the purchaser on most occasions and additionally it is clear to most consumers that if you shop at Sears, Toys R Us, Home Depot, or the corner Ice Cream shop they do not sell gift certificate for any one else except the issued gift certificate to be used at the store that issued it therefore, the goods and services are restricted to the specific store for goods and services, it may be of one service or commodity such as ice cream or many items or services such as the ones offered by Sears or Home Depot. Also it is clearly thought by both references that the certificate or voucher is electronically created, transmitted and printed for online or off-line use for obtaining goods and services.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

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to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As it can be seen by the above statements in regards to the knowledge commonly available to one skilled in the art.

8. In response to applicant's argument that Tedesco is check processing system and is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tedesco reference does resolve and suggest the use of pre-funded voucher or coupon or check that is used for obtaining goods and services. It should be also said that the Walker is also in the same environment of pre-funding a voucher to be used for obtaining goods and services, which clearly associates the said prior arts in the analogous art for combination as to resolve the claimed inventive steps of the current application.

9. Additionally it should be pointed out that the examiner has not conceded to the arguments put forward by the applicant in the office action filed on March 5, 2004. Contrary to the statements made by the applicant in page 1, 1st paragraph that;

10. "Claims 1-30 are rejected by the Examiner under 35 USC 103 as being unpatentable under Tedesco In view of Walker and "Hawaiian to offer tickets' through ATMs." Applicant has previously discussed Tedesco and Walker. In view of the Examiner's indication in the Office Action (page 2, item number 4) that a new grounds of rejection are recited, Applicant takes the view that Applicant's previous comments with regard to Tedesco and Walker have persuaded the Examiner that that combination does not render the Invention obvious under 35 USC 103.... However, as noted in the foregoing, it also appears that Applicant has overcome the Examiner's rejection for obviousness based on the combination of Walker and Tedesco. Again, Applicant repeats herein the arguments made with regard to Tedesco and Walker and notes that with regard to Hawaiian Air..."

11. Examiner does not agree with the statement presented above. As it has been clearly discussed above the new grounds of rejection were introduced based on the newly introduced amendments to the

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claims at the time of the prior office action and subsequent abandonment and revival of the application. Examiner believes the arguments provided above should clearly provide the position of the office in this regards. Clearly the provided references and combination of their teachings clearly disclose all the limitations of the currently presented claims as the have been amended.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., seller are active participant in the promotion, marketing and sale of commodities...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. As for the Hawaiian Air it has been introduced to make the obviousness reasoning that Hawaiian Air clearly shows that the coupons (Certificate) can be purchased via ATMs (Seller terminal) for an specific use (Seller selected commodity), which is buying airline tickets for flying only via Hawaiian Air. It is the seller that is actively involved in the process of coupon (Certificate) issuance and marketing.

Claim Objections

14. Claim 1 is objected to because of the following informalities: examiner believes that the claim as directed towards a system should be stating in the first paragraph of the claim "a certificate authority **module...**" rather than (a certificate authority...) Appropriate correction is required.

15. Also clarification should be made of the said "module" is hardware or software as the claim is directed towards a system.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

17. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 20-23, the "allow..." phrase makes the claims indefinite and unclear in that neither means nor

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interrelationship of means are set forth in these claims in order to achieve the desired results expressed in the "allow..." phrase.

18. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 20-23, the "adapted to..." phrase makes the claims indefinite and unclear in that neither means nor interrelationship of means are set forth in these claims in order to achieve the desired results expressed in the "adapted to..." phrase.

19. Furthermore a recitation directed to the manner in which a claimed apparatus is intended to be (Adapted to..., Allow...) used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing value bearing vouchers used be redeem for obtaining goods and services by the bearer.

20. In claim 1 paragraph 1, there seems to be a missing phrase in line 8, after the phrase "said network, said ? associated with..." correction is required.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being obvious over U.S Patent Publication No. US 2002/0062286 to Daniel E. Tedesco in view of U.S. Patent No. 6,193,155 to Jay S. Walker and "Hawaiian to Offer Tickets Through ATMs" Wall Street Journal, 6 January 1998, Page 1.

23. As per claims 1, 6, 9, 15, 16, 21, 24 and 30:

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24. Tedesco et al teaches a method and apparatus for processing checks such that Applicant's certificate authority reads on the bank device (pre-paid bank certificate), element 12, figures 1 and 2, Applicant's certificate issuance module reads on element 14 wherein Applicant's issued certificate reads on the reserved check, Applicant's public key identifier reads on the account identifier, Applicants' redemption denomination reads on the amount of funds reserved for the check, Applicant's private key reads on the reservation code, Applicant's certificate authentication module reads on element 16 wherein Applicant's authorization reads on the payee, element 16, providing to the bank, element 12 an account identifier, the redemption denomination (requested amount/amount of check); see paragraph [0060], starting at line 11, and the reservation code; see paragraph [0051], particularly the last sentence, and Applicant's means to cancel reads on the bank indicating that the check has been paid/claimed, paragraph [0064].

25. Although Tedesco mentions that goods are attained by using the pre-funded check [0067], but Tedesco is not specific on the relationship. However Walk clearly discloses the pre-funded certificate is used to pay for goods and/or services (See Walker column 5, lines 25-38 and column 9, lines 24-29). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, if not inherent to use the pre-paid bank certificate (Check) of Tedesco, to allow the pre-paid certificate of Tedesco to be pay for goods and/or services that is obtained, this would make the certificate more widely acceptable or by the virtue of connecting such certificate with a particular merchant more specific (See Walker column 1, lines 56-65 and column 2, lines 7-11).

26. Additionally, Tedesco is silent on the specificity of the nature of relation between the virtual certificate and the seller selects the commodity having value along with the commodity. However, Hawaiian Air clearly shows that the coupons (Certificate) can be purchased via ATMs (Seller terminal) for an specific use, which is buying airline tickets for flying only via Hawaiian Air. It is the seller that is actively involved in the process of coupon (Certificate) issuance and marketing. There are additional examples of such coupon (Certificates) sales by the specific seller, such as the American Express Student Air Line Discount Coupons as well as Airline Upgrade Coupons. Also it is traditionally know that stores would be selling gift certificates to the patrons for the specific use in the store or to be redeemed at the store that

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issued such certificates. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, to have a seller be actively involve in selling gift certificates that are only used for purchases in the seller's specific area of commerce, it is to insure further revenue generating mechanism.

27. As per claims 2 and 17:

Applicant's second public key identifier reads on the check identifier, paragraph [0051]. The bank stores records of the reserved checks including the check identifier, paragraph [0039].

28. As per claims 3, 4, 18 and 19:

Applicant's payment agent reads on the financial account, paragraph [0047], from which the user wishes to use for payment of the reserved check. See also/instead paragraph [0075] wherein a user credit card can be used to charge a fee for the reserved check.

29. As per claims 5 and 20:

Applicant's authorization to transfer funds is considered inherent to the system of Tedesco et al, paragraphs [0047] and [0082].

30. As per claims 7, 8, 22 and 23:

Applicant's means to deliver reads on the inherent printed check as hinted at throughout the disclosure of Tedesco et al; see the "abstract" and paragraphs [0020, 0061 and 0063].

31. As per claims 10 – 14 and 25 - 29

32. Although Tedesco et al do not specifically teach that the check is transferable to another user prior to redemption, Walker et al teach a system for issuing and managing gift certificates (the certificates are considered to be used and handled similarly to the checks of Tedesco et al), such that Walker et al disclose that a security code, selectable either by the certificate issuer (bank of Tedesco et al) or the user/purchaser of the certificate, is necessary for the redemption of a gift certificate as is required in Tedesco et al. Further, Walker et al discloses that the certificate is transferable to another user, other than the purchaser. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, if not inherent to the teachings of Tedesco et al, to allow the check of Tedesco et al to be transferred to another (as well as the reservation code) prior to redemption as is

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taught by Walker et al, as transferring of either checks or gift certificates is considered to be a common occurrence with either checks or gift certificates; see also, Walker et al "Description of the Related Art".

33. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

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(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Primary Examiner



KAMBIZ ABDI
PRIMARY EXAMINER

April 7, 2006